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PHAM, TUAN

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Response to Arguments

1. Appellant's arguments in the reply Brief filed on 10/23/2008 have been fully considered but they are not persuasive.

(I) Appellant's first argument:

In page 2 of the reply Brief, Appellant argues that the word "amulet" is "An object worn, especially around the neck, as a charm against evil or injury" as recited in claim 1.

In response to appellant's arguments, Examiner respectfully disagrees with the appellant's argument. According to the appellant's specification disclosed in page 2, ln.30-37, page 13, ln.6-11. The word "amulet" is defined no more than an electronic device which is included a transceiver and a display for wearing around the user's neck. Therefore, the limitation "amulet" in claim 1 cannot be treated as "An object worn, especially around the neck, as a charm against evil or injury" as arguing by the Appellant.

(II) Appellant's second argument:

In page 2 of the reply Brief, Appellant argues that Marshall's microphone and speaker in the hang-around neck module 200 is not suitable for telecommunication.

In response to appellant's arguments, Examiner respectfully disagrees with the appellant's argument. The module 200 is similar with the module 10 as shown in figure 2. The module 200 optionally includes microphone 206 and speaker 208 for voice communicating with the other devices (see [0054]). Therefore, module 200 is suitable for telecommunication.

(III) Appellant's Third argument:

In pages 3-4 of the reply Brief, Appellant argues that Examiner fails to combined Kanesaka in view of Marshall and further in view of Morton as recited in claim 1.

In response to appellant's arguments, Examiner respectfully disagrees with the appellant's argument. It appears applicant is attacking individual merits of Kanesaka, Marshall, and Morton and concludes that there is no impetus to combine them.

However, one must consider **the combination of references as a whole** under a 103 rejection. One cannot show non-obviousness by attacking references individually. **In re Keller**, 208 USPQ 871 (CCPA 1981). The test for obviousness is not whether features of one reference may be bodily incorporated into the other to produce claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in pertinent art. **In re Bozek**, (CCPA) 163 USPQ 545. The question in a rejection for obviousness on a combination of references is what secondary reference would teach one skilled in the art and not whether its structure could be bodily substituted in basic reference structure. **In re Richman**, 165 USPQ 509 (CCPA 1970). In this regard, the intent of Marshall and Morton as a secondary teaching is not to combine its structural features into Kanesaka, but rather to use the teaching of Marshall and Morton to combine with the teaching of Kanesaka to meet the claimed invention. **In re Oetiker**, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir.1992). It has been held that a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention.

In this case, Kanesaka, Marshall, and Morton are in the same field of the appellant's endeavor. As admitted by Appellant in page 5, Kanesaka teaches an information processing system having a first information processing device 100 (wireless mobile phone 100) for receiving and sending data information from and to base station 102 and a second information processing device 101 (second display device 101) for sending and receiving the data information from and to the first information processing device 100 (see figure 1, first information processing device 100, second information processing device 101, base station 102). In addition, the second information processing 101 can be hanging on the person's neck to communicate with other devices.

Marshall teaches a wireless personal entertainment media module 10 communicates with other wireless devices (see figure 2, personal entertainment media module 10, [0030]). In addition, the wireless personal entertainment media module 10 can be hanging on the person's neck to communicate with other devices.

Morton teaches a communication medical information storage device store the user personal profiles and display the user information to the other people (see figures 2& 4). In addition, the communication medical information storage device can be hanging on the person's neck (see figure 3).

Since Kanesaka, Marshall, and Morton are the same environment of the wireless communication system that having the personal devices which includes the display for displaying the information to the users and it can be hanging on the person's neck. Therefore, they are the same field of appellant's endeavor. For the sake of argument,

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even if Kanesaka, Marshall, and Morton are not in the field of appellant's endeavor as alleged by appellant (which Examiner disagrees as set forth above), then Kanesaka, Marshall, and Morton is reasonably pertinent to the particular problem with which the appellant was concerned. Therefore, there is an existing a strong prima facie case of obviousness under 35 U.S.C 103, and proper to combine Kanesaka, Marshall, and Morton.

(IV) Appellant's four argument:

In page 3 of the reply Brief, Appellant argues that "there would be absolutely no reason for modifying the second information processing device 101 which is shown only with a display to further include an additional microphone and speaker" and also fails to provide a motivation to combine Kanesaka and Marshall.

In response to appellant's arguments, Examiner respectfully disagrees with the appellant's argument. It is a common knowledge in the art that to have a wireless headset (e.g. Bluetooth) integrated with a microphone and speaker to wirelessly communicate with mobile phone. In this case, it is clearly seen that the second information processing device 101 can be integrated with microphone and speaker for communicating with the first information processing device 100 (mobile phone) via a wireless Bluetooth short range. Therefore, the second information processing device 101 of Kanesaka can be integrated with microphone and speaker.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

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where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to do so found in order to provide a hands-free operation.

(V) Appellant's fifth argument:

In page 4 of the reply Brief, Appellant argues that Examiner is hard to envision without hindsight reconstruction to combine Kanesaka, Marshall, and Morton as recited in claim 1.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, Kanesaka, Marshall, and Morton are in the same field of the appellant's endeavor. Kanesaka teaches an information processing system having a first information processing device 100 (wireless mobile phone 100) for receiving and sending data information from and to base station 102 and a second information processing device 101 (second display device 101) for sending and receiving the data information from and to the first information processing device 100 (see figure 1, first

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information processing device 100, second information processing device 101, base station 102). In addition, the second information processing 101 can be hanging on the person's neck to communicate with other devices.

Marshall teaches a wireless personal entertainment media module 10 communicates with other wireless devices (see figure 2, personal entertainment media module 10, [0030]). In addition, the wireless personal entertainment media module 10 can be hanging on the person's neck to communicate with other devices.

Morton teaches a communication medical information storage device store the user personal profiles and display the user information to the other people (see figures 2& 4). In addition, the communication medical information storage device can be hanging on the person's neck (see figure 3).

Since Kanesaka, Marshall, and Morton are the same environment of the wireless communication system that having the personal devices which includes the display for displaying the information to the users and it can be hanging on the person's neck. Therefore, the combination of Kanesaka, Marshall, and Morton are proper, and it is not hindsight as arguing by the Appellant.

For the above reasons, it is believed that the rejections should be maintained.

/TUAN A PHAM/

Primary Examiner, Art Unit 2618